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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/037,325

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Harry W. Eberle III

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04/02/2008

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EXAMINER

GARCIA, ERNESTO

ART UNIT

PAPER NUMBER

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/037,325	<b>Applicant(s)</b> EBERLE, HARRY W.	
	<b>Examiner</b> ERNESTO GARCIA	<b>Art Unit</b> 3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 29-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 29-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Prosecution on the merits of this application is reopened on claim 29 as being unpatentable over Fisher et al., 5,704,181, claim 30, as being unpatentable over Fisher et al. in view of Naccarato et al., 6,442,908, claim 33, as unpatentable over Mayor, 556,998, in view of Fisher et al., 5,704,181, and claim 34, as being unpatentable over Mayor in view of Fisher et al. and further in view of Naccarato et al. The arguments made against replacing metal for plastic in Fisher et al. and Mayor has been found persuasive as these references do not directly state using plastic. However, a new reference to Achheim, 6,012,256, found from a forward/backward search of Fisher et al. suggests the use of plastic or other material. Further, a new reference to Curtis, Jr. has been found and suggests the use of recesses on the support member. Accordingly, these claims are not deemed to be allowable at this time. Prosecution is being reopened so that the new reference can be applied to claims 29, 30, 33, and 34.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 102***

Claims 29, 31 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Great Britain patent, GB-1,350,754 to Child.

Regarding claim 29, the British patent discloses, in Figure 10, an anchoring device consisting essentially of a substantially flat horizontal top element **A10** (see marked-up attachment provided in the last Office action), at least one substantially vertical support member **A20**, and a substantially flat horizontal bottom element **A30**. The top element **A10** has a top view configuration including two sides **A2** and a predetermined first width **A3** as measured side to side. The first width **A3** is measured at a maximum width between the sides **A2**. The top element **A10** has an imaginary center line **A4**. The support member **A20** is attached to an underside **A6** of the top element **A10** along the center line **A4** and the support member **A20** extends downwardly therefrom. The support member **A20** has two sides **A7** and a predetermined second width **A8** as measured side to side at a maximum width. The bottom element **A30** has a flat bottom view configuration, which includes sides **A31**, and having a generally trapezoidal shape, and a predetermined third width **A11** as measured side to side at a maximum width at a trapezoidal base **B1**. The first width **A3** is greater than the second width **A8** and the third width **A11**. The third width **A11** is greater than the second width **A8**. The device is made of molded plastic material (column 4, lines 72-84).

Applicant is reminded that the anchoring device can be adapted to main the top element in a predetermined position during use for joinder of two adjacent boards which have been pre-cut with receiving slots, and to position the bottom element upon a

Art Unit: 3679

support board which two adjacent boards rest for attachment of the anchoring device to the support board for anchoring and support of the two adjacent boards.

Further, for the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising". See, e.g., PPG, 156 F.3d at 1355, 48 USPQ2d at 1355. See MPEP 2111.03.

Regarding claim 31, the two sides **A2** of the top element **A10** are symmetric relative to one another.

Regarding claim 32, the two sides **A2** of the top element **A10** are parallel to one another.

Claims 33 and 35-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Chen et al., 6,363,677.

Regarding claim 33, Chen discloses in Figure 5, a decking system comprising boards **A20** (see marked-up attachment provided in the last Office action) and an anchoring device **A26**. Each of the boards **A20** has a top **A21**, a bottom **A22**, two sides **A23** and two ends **A24**. At least one groove **A25** is located along one of the sides **A23**.

Art Unit: 3679

The anchoring device **A26** consists essentially of a substantially flat horizontal top element **A1**, at least one substantially vertical support member **A5**, and a substantially flat horizontal bottom element **A9**. The top element **A1** has a top view configuration including two sides **A2** and a predetermined first width **A3** as measured side to side. The first width **A3** is measured at a maximum width between the sides **A2**. The top element **A1** has an imaginary center line **A4**. The support member **A5** is attached to an underside **A6** of the top element **A1** along the center line **A4** and the support member **A5** extends downwardly therefrom. The support member **A5** has two sides **A7** and a predetermined second width **A8** as measured side to side at a maximum width. The bottom element **A9** has a flat bottom view configuration, which includes sides **A10**, and having a generally trapezoidal shape, and a predetermined third width **A11** as measured side to side at a maximum width at a trapezoidal base **B1**. The first width **A3** is greater than the second width **A8** and the third width **A11**. The third width **A11** is greater than the second width **A8**. The device is made of molded plastic material capable of having a metal fastener driven through (col. 7, lines 56-60).

Applicant is reminded that the anchoring device can be adapted to main the top element in a predetermined position during use for joinder of two adjacent boards which have been pre-cut with receiving slots, and to position the bottom element upon a support board which two adjacent boards rest for attachment of the anchoring device to the support board for anchoring and support of the two adjacent boards.

Further, for the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising". See, e.g., PPG, 156 F.3d at 1355, 48 USPQ2d at 1355. See MPEP 2111.03.

Regarding claim 35, the two sides **A2** of the top element **A1** are symmetric to one another.

Regarding claim 36, the groove **A25** establishes an upper half **A30** of each of the boards **A20** above the groove **A25** and a lower half **A31** of each of the boards **A20** below the groove **A25**. The upper half **A30** has a greater width than the lower half **A31**. Compare widths **A32** and **A33**.

Regarding claim 37, the boards **A20** are made of material selected from the group consisting of synthetic polymers, at least partially foamed synthetic polymers, wood, wood composite, and combinations thereof (col. 4, lines 22-50).

Regarding claim 38, the two sides **A2** of the top element **A1** are parallel to one another.

***Claim Rejections - 35 USC § 103***

Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher et al., 5,704,181, in view of Aschheim, 6,012,256.

Regarding claim 29, Fisher et al. disclose, in Figure 3, an anchoring device comprising a substantially flat horizontal top element **14b**, at least one substantially vertical support member **14c**, and a substantially flat horizontal bottom element **14a**. The top element **14b** has a top view configuration including two sides **A2** (see marked-up attachment provided in the last Office action). and a predetermined first width **A3** as measured side to side. The first width **A3** is measured at a maximum width between the sides **A2**. The top element **14b** has an imaginary center line **A4**. The support member **14c** is attached to an underside **A6** of the top element **14b** along the center line **A4** and the support member **14c** extends downwardly therefrom. The support member **14c** has two sides **A7** and a predetermined second width **A8** as measured side to side at a maximum width. The bottom element **14a** has a flat bottom view configuration which includes sides **A10** and having a generally trapezoidal shape, and a predetermined third width **A11** as measured side to side at a maximum width at a trapezoidal base **B1**. The first width **A3** is greater than the second width **A8** and the third width **A11**. The third width **A11** is greater than the second width **A8**.



However, Fisher et al. fail to disclose the device made of molded plastic material. However, Fisher et al. suggest at column 6, lines 2-13, that changes in material may be made and since the grout mixture would change depending upon the anchoring device, i.e., the beam, being used, one would be motivated to use a plastic anchoring device suitable with a grout mixture to be used with plastic for making a play house. Furthermore, Aschheim teaches in column 1, lines 22-27, that anchoring device, i.e., the sustainer, can be made of plastic as an alternative material for sustaining episodic loads. Therefore, as taught by , it would have been obvious to one of ordinary skill in the art at the time the invention was made to. Given the modification, it is known that plastic material is capable of having a metal fastener driven through.

Applicant is reminded that the anchoring device can be adapted to main the top element in a predetermined position during use for joinder of two adjacent boards which have been pre-cut with receiving slots, and to position the bottom element upon a support board which two adjacent boards rest for attachment of the anchoring device to the support board for anchoring and support of the two adjacent boards.

Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher et al., 5,704,181, in view of Aschheim, 6,012,256, as applied to claim 29, and further in view of Naccarato, 6,442,908.

Regarding claim 30, Fisher et al., as modified above, fail disclose the vertical support member **14c** having recesses with support columns located therebetween. Naccarato et al. teach, in Figs. 4 and 5, a vertical support member **14c** having recesses **15** to promote optimal flow of grout material through the support member (col. 5, lines 29-35). Therefore, as taught by Naccarato et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to include recesses in the vertical support member to promote optimal flow of grout material through the support member. Applicant is reminded that columns will be inherently located between the recesses as shown in Figure 3 of Naccarato et al.

Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Child, GB-1,350,754, in view of Curtis, Jr. 4,154,172.

Regarding claim 30, Child, as discussed fails to disclose the vertical support member having recesses with support columns located therebetween. Curtis, Jr. teaches in Figure 2 and 4, a support column 17',21 having recesses to allow the insertion of a fastener therethrough (col. 2, lines 30-33, and col. 2, line 68, to column 3, line 4. Therefore, as taught by Curtis, Jr., it would have been obvious to one of ordinary skill in the art at the time the invention was made to include recesses on the vertical support member to allow the insertion of a fastener. Given the modification, support columns would have been located between the recesses in general.

Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al., 6,363,677, in view of Curtis, Jr. 4,154,172.

Regarding claim 34, Chen et al., as discussed fails to disclose the vertical support member having recesses with support columns located therebetween. Curtis, Jr. teaches in Figure 2 and 4, a support column 17',21 having recesses to allow the insertion of a fastener therethrough (col. 2, lines 30-33, and col. 2, line 68, to column 3, line 4. Therefore, as taught by Curtis, Jr., it would have been obvious to one of ordinary skill in the art at the time the invention was made to include recesses on the vertical support member to allow the insertion of a fastener. Given the modification, support columns would have been located between the recesses in general.

### ***Response to Arguments***

Applicant's arguments with respect to claims 29, 30, 33, and 34 have been considered but are moot in view of the new grounds of rejection.

Applicant's arguments filed with the appeal brief filed December 31, 2007 have been fully considered but they are not persuasive.

Applicant argues that the British patent fails to disclose the grouting strip used similarly as applicant's invention. In response, it should be noted that the method of

using the anchoring device is not what is being claimed but rather the anchoring device by itself. If the same structural features are present in the reference, then it would inherently be capable to perform equally well since there's nothing in the reference that would preclude from using the invention as the applicant have done. If the applicant believes that a new method of utilizing the same anchoring device, then applicant should considered applying for method claims.

Applicant further argues that the top is not the top but rather the bottom and that the bottom is the top. The argument has been acknowledged and it is unpersuasive since the top and bottom are relative terms. Applicant further argues that a person having ordinary skill in the art would see that the strip of the British patent and the claimed anchoring device in claim 29 has material structural differences inherent in their different functions. In response, it should be noted that patentability is based on the structural difference of the claimed invention over the prior art and not what on their functional differences. Apparently, if the same feature is in the prior art, then it would inherently perform as stated.

Applicant further argues that the adapted limitations are no mere statements of intended use, but rather are structural limitation, albeit recited in functional language. In response, it should be noted that none of the structural features imparts structure. If so, what structure would that be? Further, it should be noted that the "adapted to" limitation merely recite what the structure is able to do and not what it is doing. Accordingly, the

Art Unit: 3679

strip of the British patent is capable of functioning as claimed since nothing precludes it from being used the same way as applicant's claimed invention.

Applicant further argues that the British patent has recesses that are not grooves. In response, this argument is irrelevant to the rejected claims since the rejected claims do not positively require grooves nor are the tiles being claimed.

With respect to Chen et al., the same responses to the arguments made to the British patent apply to Chen et al. as well.

Applicant argues that the examiner has not pointed to "any single structure that embodies the anchoring device included in the system of claim 33. In response, it should be noted that claim 33 does not require that there be a "single structure" and thus the argument is not commensurate with the claimed invention.

### ***Conclusion***

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Buchet, 2,647,837, and Lowinger, CH-278,212, show a similar anchoring device. Browne, 2,526,116, and Livezey, Jr., 3,045,294, disclose a similar decking system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernesto Garcia whose telephone number is 571-272-7083. The examiner can normally be reached from 9:30AM-6:00PM. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached at 571-272-7087.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/E. G./

Examiner, Art Unit 3679

April 2, 2008

/Daniel P. Stodola/  
Supervisory Patent Examiner, Art Unit 3679